

**REMARKS***Request for Telephonic Interview Reiterated*

As an initial note, Applicants reiterate their written request for a telephonic interview as previously set forth on February 11, 2009. Prior to issuing a subsequent office action in this matter Applicants request that the Examiner grant the requested interview so as to expedite the prolonged prosecution of this application.

The non-final Office Action of September 18, 2009 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Applicants wish to clarify the status of the instant application. While agreeing that claims 1-24 and 31-36 remain pending, Applicants correctly note that the prior response of February 11, 2009 was filed as a request to reopen prosecution (under 37 CFR §41.39(b)(1)), not as a request for continued examination. Moreover, that request was made based upon the Board of Appeals and Interferences' order remanding the appeal to the Examiner for further consideration, and the Examiner's entry of a new ground for rejection under 35 U.S.C. §101.

Furthermore, in spite of the incorrect indication at page 5 (Item 10) that the current Office Action is made final<sup>1</sup>, no such indication has been set forth elsewhere and the Office Action Summary indicates this is a non-final action. Nor has any other indication of finality been provided or the requisite indication of an early response option been stated. Accordingly, Applicants understand the current Office Action to be a non-final action to which this reply is believed to be responsive. In the unlikely event that the Office Action of September 18, 2009 is somehow construed as being a final action, Applicants hereby petition to withdraw the finality of the action, or in the alternative, request that this response be further considered as a Notice of Appeal to preserve Applicants right to further address the outstanding rejections.

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<sup>1</sup> As noted herein, item 10 is part of a large portion of the Final Office Action sent February 2005 that was copied, verbatim and inserted into the Office Action of Sept. 18, 2009, purportedly in response to Applicants amendments and remarks. Like item 10, numbered items 2 -9 and 11 are similarly believed to be of little relevance as several of the claims have since been amended and Applicants have previously addressed the previous Examiners response in the appeal documents.

*Office Action Summary*

Turning now, to the office action, Claims 3, 4, and 31-36 remain rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1-15, 19, 22-24, 31-32 and 35-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wilk, U.S. Patent No. 5,437,278 ("Wilk") in view of Bodick et al, U.S. Patent No. 4,945,476 ("Bodick"). Claims 16-18, 20-21 and 33-34 were rejected under 35 U.S.C. §103(a) as unpatentable over Wilk in view of Bodick and Kehr et al, U.S. Patent Application Publication No. US 2003/0036683 ("Kehr").

*35 U.S.C. §101 Rejections Respectfully Traversed*

Applicants respectfully traverse the rejection of claims 3, 4, and 31-36 under §101 in light of the amendments to claim 3 and in view of the Examiner's failure to address the distinct structural limitations recited in claims 31-36. More specifically, amended independent claim 3 now positively sets forth the machine (computer, and mass storage device operatively associated with the computer) upon which the database resides, along with the diagnostic engine for generating possible diagnoses. In view of the amendments to claim 3, Applicants submit that claims 3 and 4 are tied to a statutory class and meet the requirements of 35 U.S.C. §101.

With respect to claims 31-36, Applicants respectfully urge that the Examiner has incorrectly stated that the claims "contain similar limitations." If the Examiner's reference is meant to be relative to claim 3, Applicants respectfully request the Examiner to carefully review claim 31. In particular, Applicants note that claim 31 includes positive recitations of a computer, the image database and knowledge database both being accessible by the computer, a user-interface, and a diagnostic engine operated by the computer. Having positively recited various aspects of the computer that accomplishes the method steps, Applicants respectfully urge that claim 31 remains improperly rejected under §101. Accordingly, withdrawal of the rejection relative to claims 31-36 is respectfully requested. In the event the rejection of claims 31-36 is somehow maintained, the Examiner is requested to clarify why the recited structural elements are insufficient to overcome the rejection.

*Rejections Under 35 U.S.C. §103 Respectfully Traversed*

With respect to what appears to be a thorough response to Applicants prior response (Items 1-11; p. 2-6 of Office Action as noted in the footnote above), Applicants note that the Response to Arguments contained in the Office Action of Sept. 18, 2009 is merely a verbatim copy of the prior Examiner's (Ex. Hayes) remarks found in the Final Office Action dated May 31, 2005. Applicants further note that the pending claims have been amended since that point and as a result the copied response to arguments, at best, fails to address the current claims and arguments related to such claims. While Applicants would normally respond to such a response, no such response is believed necessary as such points have been previously addressed in the prior prosecution of this application.

**Claims 1-15, 19, 22-24, 31-32 and 35-36** were rejected under 35 U.S.C. §103(a) as being unpatentable over Wilk in view of Bodick.

Applicants continue to submit that the claimed invention is unique and has extensive application and utility. Under section 35 U. S. C. §103, the Patent and Trademark Office must make out a case of *prima facie* obviousness. To reach a proper conclusion under §103, the decision maker must step backward in time and into the shoes worn by the person of ordinary skill in the art when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether the claimed invention as a whole would have been obvious at that time to that person. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts. If itself a fact, it would be part of its own foundation. . . . a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990; *emphasis added*)). See also *In re Gordon*, 221 USPQ 1125, (Fed. Cir. 1984); *Jones v. Hardy*, 220 USPQ 1021, (Fed. Cir. 1984).

Finally, the Examiner may not use the Applicants' disclosure as a recipe for selecting portions of the "prior art" to construct Applicants' claimed invention. A piecemeal reconstruction of the prior art patents in light of Applicants' disclosure is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 ( CCPA, 1972). Moreover, this teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The disclosures of Wilk and Bodick are both directed to automated medical diagnosis. Applicants respectfully contend that the inherent ambiguity of medical diagnosis requires, not automated diagnosis, but a system and method for knowledge presentation that facilitates rapid comparison and perception by the user - an essential distinction set forth in the rejected claims. The ability of the human eye to make visual comparisons between thousands of possibilities is impossible, yet when choices are constrained to a few, recognition is near instantaneous. The purposeful design of the claimed system and method set forth in the claims combine medically relevant knowledge to filter or "presort" the search results to a manageable number of diagnostic possibilities. This combination of a medical knowledge base interwoven with visual representations of possible diagnoses, which provide the ability for a system user to visually match what the user sees displayed relative to the patient, is not believed to be described by Wilk, Bodick or any of the references made of record.

Applicants further note that the presentation of a plurality of images (e.g., amended claim 1), for example in the claimed diagnostic stack (e.g., claim 6), constitute patentably distinguishable aspects the claimed invention. While there may be decision support systems used in human medicine, none are believed to support presentation of visual knowledge using a plurality of diagnoses and images, moreover none allow for the display of visual complexity, reorganized in response to the user search as recited in the limitations of the current claims.

Applicants respectfully maintain that the rejection under 35 USC §103(a) must fail because Wilk and Bodick are not properly combined to establish *prima facie* obviousness. As previously noted, the two patents teach away from one another and fail to support the combination/modification urged as the basis for the rejection. In response to Applicants arguments set forth in the Brief, the Examiner's Answer repeats (essentially in verbatim) the Examiner's response in the Final Office Action of May 2005 (p. 3, item 2). Notably that prior response did not address Applicants' argument relative to the improper combination of Wilk and Bodick, particularly in view of Wilk teaching away from Bodick.

Wilk is clearly directed to a medical diagnostic system described as having a device 20 for monitoring and measuring a biological or physiological parameter, transmitting

the parameters to a computer 24, and ultimately communicating a medical diagnosis as determined by the computer. As set forth at col. 3, lines 58 – 63, "[b]ecause diagnoses are made by computer in accordance with the present invention, it is frequently unnecessary to have a doctor present during data taking (symptom recording and measurement) and communication of the diagnosis to the patient." (underlining added).

Bodick, directed to the creation and editing of a knowledge base for use as an aid to the cognitive process of diagnosis, discloses the creation of a knowledge base containing both pictorial images and textual information therein (col. 2, lines 39-40), along with a system to use such information in a medical diagnosis. Applicants continue to urge that when taken in context, Wilk does not suggest the use or display of an image as described by Bodick (at best the cited language indicates a reduction in the time for examination, not necessarily diagnosis) – one of ordinary skill in the art would not be so motivated as the "Computer 24 is operated ... to derive a diagnosis..." (Wilk; col. 4, lines 65-69). It also remains unclear what would have motivated one skilled in the art to modify Wilk's automated medical diagnostic system to make it "unautomated" and used for searching of case data as required by Bodick.

Rather, Applicants respectfully urge that the claims of the instant application have been used as the "recipe" from which elements of the cited patents have been selected. (*see In re Kamm et al., In re Gordon, Jones v. Hardy, and In re Vaeck as referenced above*). Accordingly, Applicants continue to urge that the proposed modification of Wilk in view of Bodick is improper in view of the teaching away by Wilk, and independent claims 1, 3, 5, and 31 are respectfully urged to be in condition for allowance.

Applicants have previously questioned the Examiner's basis for a combination or modification of Wilk in view of Bodick, and in response the Examiner continues to indicate that Wilk is interpreted as disclosing an aid to diagnosis. As noted above, and previously (e.g., Appeal Brief & Reply Brief), this is a mischaracterization of the teachings of Wilk as a whole, which is identified as being directed to a "medical diagnostic system" (e.g., col. 4, line 29) "...to derive a diagnosis..." (col. 4, line 69), where the relationship to a physician is stated as "eventually sees a physician for confirming the diagnosis" (col. 3, lines 64-65) - not as an aid.

As the basis for the combination or modification of Wilk in view of Bodick, the Examiner states in the current rejection, after having set forth where aspects of the claimed invention are alleged to be taught by Bodick, that"

"Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's [sic] invention to modify the system of Wilk and incorporate the ability to identify a subset of possible diagnoses based upon a sample of characteristics and further to display the images or other data related to the subset as taught by Bodick et al. Bodick et al provides motivation by indicating that these features would benefit doctors or physicians by assisting them in searching information that would help them in diagnosing a medical condition (Col. 1, lines 10-16; Col. 2, lines 1-6)."

*Sept. 18, 2009 Office Action (p. 9)*

The diagnostic system disclosed by Wilk is not designed to assist a user in identifying a diagnosis, and the Examiner's argument continues to disregard the need to tolerate ambiguity and complexity of medical diagnoses. Applicants respectfully stress this distinction and further note that the patient-physician interaction requires timely decisions facilitated by the claimed invention where, for example, user-entered characteristics are employed to identify a subset of diagnoses, which are then used to automatically reorganize an information space of an image database for presentation to the user, and the presentation is accomplished through the concurrent presentation of a plurality of images for user review.

Applicants continue to question how one of skill in the art (which may or may not be a "medical professional" as apparently urged by the Examiner at p. 2 (line 8) of the Office Action) would be motivated to modify Wilk to add identification of a subset of diagnoses or to display images relating to the subset, when Wilk clearly taught the communication of "a diagnosis" to the patient (e.g., col. 3, line 62) and the communication of the diagnosis via output device (Printer 30; Fig 1) in step 40 (see e.g., col. 5, lines 1-3). What motivation would there be to display Bodick's images to a patient that has been diagnosed by the Wilk system, particularly when Wilk indicates that the computer conducts an image comparison (col. 2, lines 46-56)?

As Applicants have previous discussed, Wilk's automated diagnostic system teaches away from an aid in a visual diagnostic process as recited by the rejected claims. If that were not the case, why would Wilk indicate that the diagnosis is made by the

computer? In the current Office Action the Examiner again urges that Wilk's suggestion that the diagnosis may be confirmed "[supports] the idea that the invention may be used as an aid rather than a final diagnosis." (p. 3). Applicants question whose "idea" is being supported – Wilk's, Bodick's, or perhaps more likely, Applicants' idea as set forth in the application and rejected claims?

Applicants respectfully maintain that Wilk's use of the term "confirm" clearly establishes that a diagnosis was made, and the indication that it is "confirmed" by a physician supports the intent of Wilk to provide an automated medical diagnostic system - thereby teaching away from a subset including a plurality of diagnoses. In light of Applicants' prior arguments, as well as those present herein, it is apparent that the motivation relied upon for the proposed modification of Wilk is found in the instant application, not in any teaching or suggestion that would have been known to one skilled in the art without the benefit of Applicants' application. Accordingly, Applicants respectfully maintain that the rejection applies an improper standard in the conclusion that it was obvious to combine or modify the Wilk and Bodick patents. For this reason, independent claims 1, 3, 5 and 31 are respectfully urged to be non-obvious and in condition for allowance.

While Wilk does disclose the storage of images, it does not disclose the storage of images in an image database, nor the cross-referencing of the image database with a knowledgebase for purposes of assisting in the diagnostic process as recited in the rejected independent claims (e.g., claims 1, 3, 5 and 31). Applicants' review of Wilk did not identify reference to a database, let alone separate image and knowledge databases. Rather, what was found was reference to bulk storage and memory (e.g., 28 in Fig. 1), which clearly do not teach the separately recited image database and knowledge database as set forth in the rejected claims.

The Examiner further urges, at page 3 of the Office Action, that Wilk's teaching of image comparison "seems to suggest that the computer processing or knowledgebase is separate from the stored images." Applicants respectfully contend that a standard of "seems to suggest" is improper as the basis for a holding of obviousness. The Examiner has improperly characterized the teachings of Wilk. No support has been set forth to establish that one of skill in the art would have identified a knowledge database in Wilk, let alone a knowledge database separate from the image database. There simply is no teaching or suggestion in Wilk of the recited limitation of an image database and a knowledge database, where the knowledge

database is cross-referenced to the image database (e.g., claim 1), nor has the Examiner demonstrated how or why one of skill in the art would have arrived at the understanding that has been alleged in support of the rejection. Thus, *prima facie* obviousness cannot be established based upon Wilk's alleged teachings.

As previously conceded during examination, Wilk fails to disclose identifying a subset of diagnoses and using the subset of diagnoses to reorganize an information space of the image database for concurrent presentation of a plurality of images for user review via the user-Interface as set forth in the appealed claims. Nonetheless, to make up for the acknowledged gap in Wilk's teachings, the rejection relies upon Bodick and urges that Bodick teaches the limitations of the independent claims not taught by Wilk. Bodick discloses the creation of a knowledgebase containing both pictorial images and textual information therein (col. 2, lines 39-40). The system is further described as being dynamic; to permit the addition of newly discovered characteristics observed in patients and deletion of characteristics having little diagnostic importance. As Bodick points out, the disclosed knowledge base is distinct from a classic database (col. 3, lines 12-16).

Although Bodick does describe alternative methods of accessing the knowledge base (by cases having specific features or by cases in which a particular disease was diagnosed; col. 5, lines 42-48), Applicants respectfully maintain that such a teaching does not give rise to the recited limitations of "automatically identify[ing], from a plurality of possible diagnoses, a subset including a plurality of diagnoses that are consistent with the characteristics." It is further urged that Bodick and Wilk both presuppose that there is always a diagnostic answer, when in fact there is often no definitive answer in human medicine.

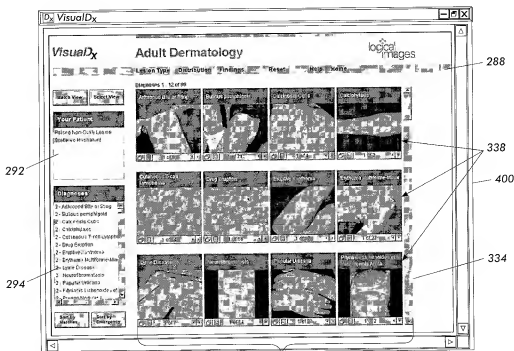
Accordingly, particularly with regard to the claimed limitation of "automatically reorganizing an information space of said image database for concurrent presentation of a plurality of images for user review," Applicants respectfully submit that no such teaching is found in Bodick, and that Bodick, in fact, teaches away from such a limitation. For example, at col. 2, lines 59-61, where a comparison is described between "one patient or sample" and a "previous patient or sample" there is nothing to suggest that more than a single representation is displayed at one time – resulting in a user having to remember a prior image(s). Similarly, col. 6, lines 19-22 of Bodick clearly indicate that information from a single record is displayed – not



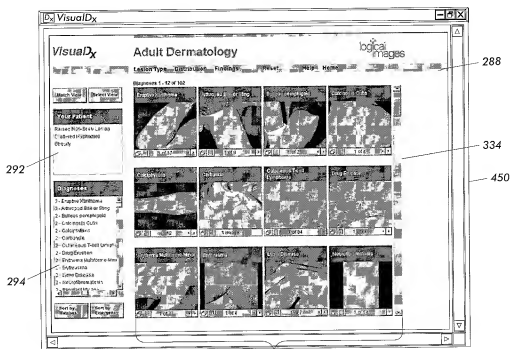
the concurrent presentation of a plurality of images for user review, reflecting a subset of diagnoses, as recited in the rejected claims (e.g., claim 1).

Even considering, *in arguendo*, a combination of Wilk in view of Bodick, at most the combination teaches the use of a common collection of data or knowledge for an automated medical diagnostic system. The modifications "suggested" by Bodick (with arguments to the contrary presented previously) would, at most, result in a system where the data of the Wilk system may be searched and text and/or an image from a case displayed to a user of the system as suggested by Bodick. Such a combination or modification does not, however, teach the automated identification of a subset having a plurality of diagnoses, in response to characteristics, let alone using the subset of diagnoses, automatically reorganizing an information space of the image database for concurrent presentation of a plurality of images for user review as set forth in the independent claims.

To assure proper consideration of these limitations, Applicants direct the Examiner's attention to pages 25 – 28 of the Specification, and to the following representations of Figures 12 and 14. The figures illustrate the response of the claimed system to additional characteristics (findings) to depict the reordering of the information space as illustrated by the change in images/ordering in response to the addition of the "obesity" characteristic in window 292.



298  
FIG. 12



298  
FIG. 14

Clearly, neither Wilk nor Bodick teach the automatic reorganizing of an information space and concurrent presentation of a plurality of images for user review, as recited in independent claims 1, 3, 5 and 31. The claims are, therefore, patentably distinguishable over the arguable combination.

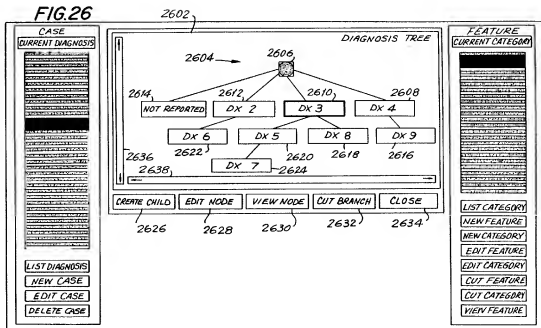
The Office Action (p. 4) urges that Bodick's teaching of side-by-side presentation of image and text information "seems to suggest that a concurrent display of a plurality of images." (Examiner's Answer p. 11, lines 9-10) Applicants, once again, maintain that "seems to suggest" is not the proper standard for an obviousness rejection, and that for this reason alone the rejection should be overturned.

Moreover, it does not appear, from the numerous display examples shown in Bodick, that there is a display depicting a plurality of images. Moreover, Bodick teaches, relative to Figs. 13A, 14 and 14A, "[t]he flow chart of FIG. 14A, which is reached from the flow chart of FIG. 13A, depicts how this viewing of an image is carried out, and FIG. 14 illustrates a display screen of what is viewed by the expert." (col. 23, lines 65-68; emphasis added). Thus, in spite of the Examiner's urging to the contrary, Bodick teaches a single image display and fails to teach or suggest the concurrent presentation of a plurality of images associated with a subset of diagnoses for user review as recited in the rejected claims. In view of the above-noted arguments in traversal of the rejection, Applicants' respectfully request that the Examiner overturn the rejection of claims 1, 3, 5 and 31 and indicate their allowance.

With regard to dependent claims 2 and 4, the Office Action does not appear to address Applicants' prior remarks set forth in the Appeal Brief. Applicants continue to urge that the Examiner has mischaracterized the search capability of Bodick. Claims 2 and 4 recite automatically reorganizing the information space in response to a user's modification of a descriptive characteristic. The recited feature is depicted, for example, in Figures 7 and 8 and described at page 24 of the as-filed application, and as also described above in Figures 12 and 14 – where a user's selection or entry of a descriptive characteristic results in the reorganization of the information space and alteration of the images displayed. No such teaching has been identified or illustrated in Bodick.

Considering the rejection of claims 6 – 11 and 31, the Examiner acknowledges that Wilk [sic] fails to teach an image stack, yet maintains that Bodick discloses a diagnostic image stack, as recited in the rejected claims, by disclosure of a diagnostic tree in Figure 26. To further illustrate the teachings, Figure 26 of Bodick is excerpted

below for convenience, as is the description of the figure from column 21 (lines 17-49).



the current category from the dictionary.

Home screen 200 is provided with a diagnosis button 244, the actuation of which causes monitor 106 to display a so-called diagnosis tree. This tree is created by the expert and is used to verify the accuracy by which diagnoses are made on the basis of observed features and diagnoses which are precedent. An example of an existing diagnosis tree is illustrated in FIG. 26, and FIGS. 27-29 illustrate the manner in which the diagnosis tree may be expanded or edited. Since each case record includes a diagnosis, the diagnosis tree is a valuable tool in recognizing how one diagnosis leads to another.

A brief and simple example of the utility of this diagnosis tree is as follows: Let it be assumed that, in the population of patients in which the knowledge base is interested, all of those patients have been diagnosed as having tumors. However, the tumor may be benign or malignant. In the diagnosis tree, these two diagnoses may be thought of as nodes of the tree, and both are on the same level and may be thought of as "siblings". For those patients having benign tumors, the next lower level of diagnoses is based upon the observation that such diagnoses appear only in patients who have benign tumors. This next lower level of diagnoses may be thought of as "children" of the preceding upper level. Similarly, the diagnosis "malignant tumor" will have dependent therefrom one or more "children" whose diagnoses are found only in patients having malignant tumors. The ability to edit the diagnosis tree permits refinements based upon experience and a greater population of cases and, of course, the expert's observations of those cases.

The flow charts of the various operations and rou-

For purposes of comparison, Applicants respectfully contend that the alleged teaching does not give rise to the claimed "plurality of images are presented as a diagnostic image stack" as found, for example, in claim 6. The Examiner is further referred to Figures 8 and 12 - 15 of the instant application, and the associated description at pages 24 - 25 of the Specification, where a description of an embodiment of the invention is found.

Applicants continue to urge that Bodick is clear as to the contents of Figure 26. At col. 9, line 22, Figure 26 is described as "a display used in selecting a diagnosis tree." Applicants remain uncertain as to what information the Examiner asserts to support the presence of a "diagnostic image" let alone the recited "diagnostic image stack" as set forth in rejected claim 6, for example. Applicants respectfully maintain that the hierarchy depicted in Bodick does not teach a plurality of images or a diagnostic image stack as the term has been employed, to characterize a group of images in the context of diagnostic possibilities, by the instant application.

Furthermore, and as previously noted, Bodick's hierarchical "tree" structure is an information strategy that is distinct from the functionality offered by the claimed image stack of the present application, and more particularly "wherein the index is independent of the common diagnosis" as found in claim 7. The present invention permits the user to enter multiple characteristics which then result in diagnoses displayed by a number of matches (see e.g., FIGS. 12 and 14 above). Accordingly, Applicants maintain that *prima facie* obviousness has not been established relative to claims reciting the diagnostic image stack, and particularly claims 6 – 11.

Applicants further note that the Office Action continues the failure to specifically address Applicants' prior arguments set forth as to claim 8 where, in spite of the noted failure to disclose the limitations of claim 8, the Examiner urges that "this would have been obvious in view of the teachings of Bodick et al. in an effort to offer a plurality of images to the physician in order to determine the nature of the particular disease associated with the current patient." (p. 13) Notably, the rejection fails to indicate to whom this would have been obvious, and what teaching or suggestion is relied upon to support such a conclusion. Absent such support, Applicants respectfully maintain that *prima facie* obviousness has not been established relative to claim 8.

With respect to claims 19 and 22-23, the Examiner again acknowledged that Wilk and Bodick both fail to teach the alternative applications (oral medications, autopsy, crime scene) set forth in claims 19 and 22-23. In spite of the admitted failure, the rejection continues to be maintained as obvious "for any purpose as suggested by Bodick et al. for the cognitive process of diagnosis." (Examiner's Answer p. 8, lines 6-8; p. 12, bottom) Absent a teaching or suggestion of the limitations set forth in the claims, Applicants continue to respectfully maintain that *prima facie* obviousness has not been established, and they continue to independently traverse the rejections of claims 19, 22 and 23. The Examiner is respectfully requested to overturn the rejection as to claims 19 and 22-23, there being no basis to support the rejection.

Applicants further note that while claim 32 was included in the general rejection, the Office Action does not specifically include a rejection for claim 32. Thus, Applicants respectfully request the Examiner's acknowledgement that claim 32 is allowable (albeit objected to perhaps?). Alternatively, in the event a rejection is subsequently set forth relative to claim 32, Applicants respectfully request an opportunity to amend and/or otherwise respond to such a rejection as of right.

With respect to the remaining rejected dependent claims, for purposes of brevity specific arguments in traversal of the rejections are not set forth herein. Applicants reserve, however, the right to independently address the patentability of such claims in a subsequent response or on appeal.

**Claims 16-18, 20-21 and 33-34** were rejected under 35 U.S.C. §103(a) as unpatentable over Wilk in view of Bodick and Kehr. With regard to the rejection, Applicants previously questioned the Examiner's "Official Notice" as to the use of icons as set forth in the claims. Even if the use of icons was known, their use in the manner specifically recited in the rejected claims is respectfully urged to be both unknown and non-obvious.

The Examiner appears to be once again rejecting these claims based upon a grounds for rejection relying on the published application by Kehr. Applicants previously noted the improper reliance upon such a document because the published application was filed on a date after Applicants' earliest claimed priority date. Thus, the published Kehr application is not properly included as the basis for an obviousness rejection. For this reason alone, the rejection should be withdrawn.

Considering the combination with Kehr, *in arguendo*, as set forth in the rejected claims, the uses are recited as, for example:

- a "symptom represented as an icon" (claim 16),
- "depicting the form of a dermatological lesion" (claim 17),
- "depicting a distribution of the dermatological lesions about a patient's body" (claim 18),
- "the shape of an oral medication" (claim 20), and
- "a color of an oral medication" (claim 21).

Absent some teaching or suggestion of the recited limitations, Applicants maintain the addition of Kehr is an incomplete attempt at a hindsight reconstruction of the recited claim elements using the claims as the "recipe," and further filling in missing elements based upon the Examiner's interpretation. Applicants also requested that Examiner set forth a suitable reference teaching all of the recited limitations, and indicate the motivation for such a combination. Absent such teachings, *prima facie* obviousness is not established and the Examiner is respectfully urged to overturn the rejection.

Applicants respectfully note that this failure to establish *prima facie* obviousness was noted in prior correspondence. Applicants previously demonstrated that the Kehr

publication was not available as of Applicants' priority filing date, and absent a showing of additional evidence the rejection of these claims, which clearly references the Kehr Publication (2003/0036683 A1), cannot be maintained. That the Examiner is now re-applying the Kehr publication as the basis for such a rejection is believed to be an indication of a failure to thoroughly review the prior prosecution in this matter.

Applicants further urge that even if considered, *in arguendo*, the addition of Kehr or other "Official Notice" as to the allegedly known use of icons does not give rise to the use of icons in the manner(s) specifically recited in the rejected claims. Accordingly, Applicants respectfully traverse the rejection, request that the rejection be overturned by the Examiner, and that claims 16-18, 20-21 and 33-34 be indicated as allowable.

### **Conclusion**

As set forth above, claims 1 - 15, 19, 22 - 24, 31-32 and 35-36 were improperly rejected under 35 USC §103(a) as being unpatentable over Wilk in view of Bodick. In the alternative, when considered *in arguendo* the rejection under 35 USC §103(a) combining Wilk and Bodick omits elements recited in the rejected claims. Second, claims 16-18, 20-21 and 33-34 were also improperly rejected under 35 USC §103(a) as being unpatentable over Wilk in view of Bodick and further in view of Kehr, particularly when the rejection improperly relies upon a "reference" available only after Applicants' earliest claimed priority date. In the alternative, the arguable combination of Wilk, Bodick and Kehr (publication) fails to set forth the enumerated limitations relative to icons.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.



In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

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